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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/817,067	04/04/97	NIELSEN	ISIS-2112

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EXAMINER
MARSCHEL, A

ART UNIT	PAPER NUMBER
1807	

DATE MAILED: 02/03/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/817,067

Applicant(s)

Nielsen et al.

Examiner

Marschel, Ardin

Group Art Unit

1807



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-36 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-36 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449; Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

If applicant desires priority under 35 U.S.C. § 120 or 371 based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. It is noted that this appears as the first sentence of the specification following the title. The status of various application(s) (whether patented or abandoned) should also be included. For example, if a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for polymers synthesized from monomers of instant claim 21 or similar monomers without the limitations given for parameters "y" and "z", it does not reasonably provide enablement for unspecified polymers as within the scope of instant claims 1-6. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. Several PNA polymers as instantly prepared from monomers which contain the structure as noted above have been prepared in the art as well as instantly described but it is noted that this chemistry requires protective groups on nucleobase as well as terminal amino groups and carboxyl groups to direct such synthesis. Due to the well known complexities of such chemical

schemes, it is undue experimentation to prepare polymers beyond such types due to a lack of guidance for any such broadly undefined polymers.

Claims 7-36 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7, lines 48-51, and claim 21, lines 25-28, cite limits on the sum of various parameters that appear to already be required due to the upper limiting values of each of the individual parameters. It is unclear as this is suggestive of other values for the individual parameters. Clarification is requested.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-6 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Summerton et al. (WO 86/05518).

Summerton et al. discloses PNA polymers wherein the

nucleobases are protected in order to facilitate polymer synthesis. These protective moieties are described on page 20, line 12, through page 22, line 14. These protective groups include bulky groups such as benzoyl and nitrobenzoyl. It is noted that such groups are included within the instant definition of conjugate groups.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 28 of U.S. application serial number 08/595,387. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of each application include common PNA polymers with conjugates bound thereto.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The disclosure is objected to because of the following informalities:

On page 13, lines 34 and 35, the word "deravative" appears to be misspelled.

In claim 7, line 4, the word "ineteger" appears to be misspelled.

Appropriate correction is required.

No claim is allowed.

Papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

February 2, 1998

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER
GROUP 1800